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Attorney Docket No. 2000.83

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Nguyen, et al

Art Unit: 1771

Serial No. 10/005,846

Examiner: Victor S. Chang

Filed: December 3, 2001

For: DIFFUSION MEMBRANE

REPLY TO EXAMINER'S ANSWER

VIA FACSIMILE
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Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply to Examiner's Answer, is filed in response to the Examiner's Answer mailed July 20, 2005. It relates to the Appeal Brief mailed June 10, 2005.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on September 19, 2005.

Janice B. Davis
Janice B. Davis

Applicants note that the Examiner in this case in the Examiner's Answer has acknowledged that: the (1) REAL PARTY IN INTEREST, (3) STATUS OF THE CLAIMS, (4) STATUS OF AMENDMENTS, (5) SUMMARY OF THE CLAIMED SUBJECT MATTER, (6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL, (7) CLAIMS APPEALED and (8) CLAIMS APPEALED are all correct. Further it is noted that Applicants provided a statement identifying (2) RELATED APPEALS AND INTERFERENCES.

Applicants note that there is no controversy on what the stated grounds of rejection is, the only issue in controversy is the Examiner's rejection of claims 1-3 and 6-11 as anticipated, under Section 102 over JP 10-017694 (computer translation), and whether claims 4 and 5 are obvious under Section 103 over JP 10-017694 (computer translation).

The Section 102 rejection based on JP 10-017694 (computer translation) is improper and must be removed. The Examiner has rejection of claims 1-3 and 6-11 as being anticipated by JP 10-017694 (computer translation) under Section 102.

To anticipate a claim, a single source must contain all of the elements of the claim. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 USPQ 81, 90 (Fed. Cir. 1986); *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d

1569, 1574, 224 USPQ 409, *411 (Fed. Cir. 1984); *In re Marshall*, 578 F.2d 301, 304, 198 USPQ 344, 346 (C.C.P.A. 1978). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. See *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 USPQ 1264, 1271 (Fed. Cir. 1984). Where a reference discloses less than all of the claimed elements, an Examiner may only rely on 35 USC § 103. See *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 USPQ 773, 777 (Fed. Cir. 1985).

JP 10-017694 (computer translation) fails to teach or suggest a process that increases the mechanical strength of a membrane by adding an elastomer comprising less than 10 percent by blend weight. The Examiner now claims that the benefit must be inherent in JP'694 (Examiners Answer page 4). The case law is clear, where a reference discloses less than all of the claimed elements, an Examiner may only rely on 35 USC § 103. However there is no rejection to claim 1-3 and 6-11 under 35 USC § 103 the only under 35 USC § 102(b). It should be clear that in a process claim that teaches increasing the mechanical strength of a membrane by adding an elastomer that in order to anticipate the claim the reference needs to teach this point. JP'694 fails to do this. The increased mechanical strength of the instant invention is clearly illustrated in the specification as filed, on page 8 in table 1.

Nowhere in JP 10-017694 is it taught, or suggests, a process that increases the mechanical strength of a membrane by adding an elastomer comprising less than 10 percent by blend weight. That is only done by the present invention. Yet this is clearly the requirement of a rejection under 35 USC § 102(b).

Claims 1-11 must be allowed under 35 USC § 102(b) as the case law is clear, where a reference discloses less than all of the claimed elements, an Examiner may only rely on 35 USC § 103.

With respect to claims 1-7, the Examiner is once again reminded that, new uses for compositions of matter are clearly allowable under the 35 USC, as can be demonstrated by the definition of the term process under 35 USC § 100(b) which reads:

(b) The term "process" means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

The current claims pending under this Official Action are drawn as method claims to a new use of a known composition of matter or material. Therefore they are essentially a new use for a known material which are clearly allowable under 35 USC § 100(b).

In the Instant Invention the microporous sheet comprising a blend of an aliphatic polyolefin and a thermoplastic olefin elastomer is a known composition of matter or material, however "the method of improving the mechanical strength of a membrane comprising the step of: providing" constitutes a new use. The Claim is written in proper method or process format in accordance with 35 USC § 100(b).

With respect to independent claim 8 the Examiner admits on page 4 of the Examiner's Answer that JP '694 is silent about the Gurley Value of its microporous membrane, yet it is clearly an element of the claim and there should be no question that to anticipate a claim, a single source must contain all of the elements of the claim. Here the Examiner clearly admits that the element is missing, the claim is rejected under 35 USC § 102(b) therefore claim 8 must be patentable over JP '694.

With respect to independent claim 9 this claim was amended in the Amendment filed on November 22, 2005, basis for this amendment can be found on page 4 of the specification as filed. The claim is written so that one of ordinary skill in the art knows that the microporous sheet was made by the dry stretch process. It should be clear from the translation Applicants' filed with the appeal that JP '694 teaches the production of a microporous membrane only

through extraction or the wet process which produces a microporous membrane with a completely different physical structure. JP '694 in paragraph 0019 clearly teaches that: the microporous membranes of this reference are produced by a plasticizer being extracted from the membrane. In Applicants' appeal brief a copy of Synthetic Polymer Membrane a Structural Perspective, by Robert E. Kesting, Second Edition, Copyright 1985 where the dry stretched process is described and pictures of the porous it forms are shown on pages 290-297 and the solvent extraction process and the porous it forms are clearly shown on pages 251-261.

The Examiner in his answer of July 20, 2005, argues that phrase dry stretch is never defined. This is not true. On page 4 of the specification Applicants teach that these membranes can be made by a dry stretch method and reference to the Kesting reference at pages 237-297. On page 290 this reference describes the Celgard® or dry stretch process:

In many respects the Celgard® process, in which semicrystalline films or fibers are extruded from the melt and porosity induced by simply stretching the finished articles in the solid state, represents the ideal insofar as the manufacturing of microporous membranes is concerned. No solvents are required.

Dry stretched would be porosity induced by stretching in the solid state, no solvent, no plasticizer. If we would have said by the

Celgard® process the Examiner would simply have objected to using a Trademark in the claim making it indefinite.

In JP'694 teaches in paragraph 0016 that a plasticizer is added, in paragraph 0017 that the polymer gel is formed into a sheet, in paragraph 0018 the sheet is stretched, and in paragraph 0019 that the plasticizer is extracted to form the microporous membrane. This is not dry stretch process; it requires a plasticizer to be extracted to create the microporous. This difference would be obvious to one of ordinary skill.

As JP'694 clear fails to teach dry stretch method for the formation of the micropores, claims 9-11 must be allowable over JP'694 under 35 USC 35 USC § 102(b).

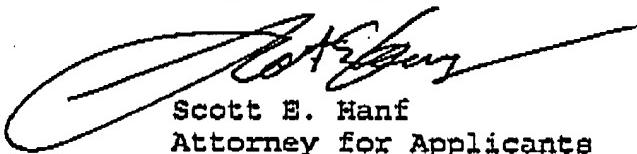
With respect to the rejection to claims 4 and 5 under 35 USC §102(b) and §103(a) as being either anticipated or as obvious from JP 10-017694 is improper and must be removed. The Examiner admits on page 4 of the Examiner's Answer that JP '694 is silent about the Gurley Value of its microporous membrane, yet it is clearly an element of the claims 4 and 5 and there should be no question that to anticipate a claim, a single source must contain all of the elements of the claim. Here the Examiner clearly admits that the element is missing, the claim is rejected under 35 USC §

102(b) therefore claims 4 & 5 must be patentable over JP '694. In order for a claim to be anticipated under 35 USC § 103 the office must make out a *prima facia* case of obviousness. The prior art reference or combination of references must teach or suggest all the limitations of the claims. See *In re Zuzko*, 111 F.3d 887, 888-89, 42 U.S.P.Q.2d 1476, 1478 (Fed. Cir. 1997); *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art."). And the teachings or suggestions, as well as the expectation of success, must come from the prior art, not Applicants' disclosure. See *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). As the Gurley Limitation has only come from Applicants' specification and not the prior art, the rejection to claims 4 and 5 must be removed and the claims allowed.

Conclusion

In view of the foregoing, Appellants respectfully request that the rejection be overturned and that the instant application be allowed to proceed to issuance. Applicants respectfully request that the Examiner either allow this case or send this appeal to the board.

Respectfully submitted,



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